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RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 1795
Docket No.: 300.1153

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Michio HORIUCHI, et al.

Serial No. 10/816,879

Group Art Unit: 1795

Confirmation No. 2665

Filed: April 5, 2004

Examiner: WALKER, KEITH D

For: FUEL CELL DEVICE

REQUEST TO EXAMINER FOR WITHDRAWAL OF FINALITY

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450
MAIL STOP AF

Sir:

Applicants request to the Examiner that the finality of the above-noted Action be withdrawn as the Action is incomplete.

Applicants herein further request the Examiner to respond to remarks submitted in the Amendment filed May 19, 2008, but unaddressed in the Response to Arguments in the outstanding Office Action. Applicants also request that a new Office Action be issued.

As noted in at least M.P.E.P. § 707.07(f), the Examiner is required to answer and address all traversals. This requirement is in addition to any repetition of a previously held position and is required to allow the applicant a chance to review the Examiner's position as to these arguments and to clarify the record for appeal.

Additionally and as further noted in M.P.E.P. § 707.07(f), a failure of the Examiner to address the applicant's traversals on the record can be deemed a failure to rebut these arguments so as to admit that the arguments have overcome the rejection. At the very least, the failure to address the applicant's traversals would render the Examiner's decision to again reject the claims arbitrary and capricious and invalid under the Administrative Procedures Act, 5 U.S.C. § 706, the standard under which such rejections are reviewed in view of Dickinson v. Zurko, 527 U.S. 150, 50 USPQ2d 1930 (1999).

In the Amendment filed with the RCE of May 19, 2008, Applicants amended claim 1 to recite "the anode layer being directly exposed to and surrounding the flame and the cathode layer being isolated from the flame, but exposed to air."

Unable to find within the Office Action where the Examiner had addressed at least the new amendment to claim 1, Attorney for Applicant telephoned Examiner Walker to discuss the rejection.

In the conversation on August 11, 2008, Examiner Walker indicated that his intended rejection interpreted Nikura in FIG. 5, as describing a flame touching an anode in combination with Iwazawa in FIG. 4, wherein the Examiner indicated that he interpreted Iwazawa as describing an anode surrounding a center. Applicants respectfully request that such an interpretation be set forth in the next Office Action, with specific references to the Iwazawa reference and figures including specific references to which structures within Iwazawa the Office Action interprets as describing the claimed "anode layer" and "surrounding the flame."

Specifically, Applicants note that the structure of the fuel electrodes 51c and 52c, in FIG. 4 of Iwazawa is of a shape wherein when combined with a flame from Nikura, that is, a single flame, or "the flame," as claimed, would not be surrounded by an anode layer, as a flame within the gap between fuel electrodes 51c and 52c, in any one particular area where a flame would be introduced, would not be capable of "surrounding" the flame.

Further, Applicants are uncertain as to the Examiner's interpretation of the claimed "the cathode layer being isolated from the flame, but exposed to air." FIG. 4 of Iwazawa would appear to show that the fuel electrodes 51c and 52c are not completely enclosed, and that gaps exist therein, providing an opening where a connector 54 and nickel felt 55 exist, such that the

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air electrodes 51b and 52b would not necessarily be "isolated from the flame," as claimed.

Applicants submit that a specific rejection is at least necessary for Applicants to clarify the issues for appeal.

Accordingly, in view of the above remarks, Applicants respectfully request a withdrawal of the finality of the outstanding Office Action.

Since the Examiner has not addressed all of the Applicants' traversals presented in the Amendment of May 19, 2008, it is respectfully requested that the Examiner withdraw the Final Office Action and issue a new Office Action addressing the arguments resubmitted above, from the Amendment of May 19, 2008.

Respectfully submitted,

STAAS & HALSEY LLP

Date: _____

11/18/2008

By: _____

Michelle M. Koeth

Michelle M. Koeth

Registration No. 60,707

1201 New York Avenue, N.W., 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501



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LETTER TO THE EXAMINER REGARDING REQUEST TO WITHDRAWAL FINALITY

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450
MAIL STOP AF

Sir:

This letter is in response to the Decision on Petition mailed November 10, 2008. Applicants respectfully submit that the Request for Withdrawal of Finality filed November 3, 2008, was not a Petition to the Director, but a Request to the Examiner to withdraw the finality of the Final Office Action mailed August 1, 2008.

It is noted that 37 C.F.R. § 1.181 indicates that a Request for reconsideration is needed and a respective action by the Examiner is appropriate before a Petition is filed. Applicants are awaiting the reconsideration by the Examiner and a reply to the Request, so that the advisability of filing a Petition can be determined.

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Accordingly, Applicants submit that the requirements of 37 C.F.R. § 1.181 do not apply, and therefore, request consideration of the Request for Withdrawal of Finality concurrently refiled herein.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 11/18/2008

By: Michelle M. Koeth
Michelle M. Koeth
Registration No. 60,707

1201 New York Avenue, N.W., 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501